



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/559,857

04/27/2000

Takatoshi Suzuki

CANO006

2360

7590

04/30/2004

Rossi & Associates

PO Box 826

Ashburn, VA 20146-0826

EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2615

8

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/559,857

Applicant(s)

SUZUKI, TAKATOSHI

Examiner

Vincent F. Boccio

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Election.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 and 19-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2615

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

**Election/Restrictions**

1. Claims 6-15, 19-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected embodiment/group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi et al. (US 6,020,982).

Regarding claim 1 and 16 Yamauchi discloses and meets the limitations associated with a method and corresponding apparatus comprising:

- receiving means (card slot or unit 600), for receiving images stored in a storage medium (Fig. 62, memory card slots "614 & 615", are sources of images);
- storage means ("record destination", met by one of "card 1 or card 2 or HDD or DDD") for storing the images received through the receiving means from the

Art Unit: 2615

- storage means (met by "record source", and one of "card 1 or card 2 or HDD or DDD");
- copy instruction means (Fig. 105 A, provides for user inputs for copying from a source to a destination);
  - control means for copying from s-medium to s-means, without generating any thumbnail images when the copy instruction of given (Fig. 105 A, "storing" and/or "image copy", Fig. 106, "image dubbing" and/or storing, source to destination without thumbnail processing of images),

wherein the system also meets the limitation of providing a thumbnail generator as shown in Fig. 87 B, the processing option {2}, provides a means for processing images, according to Fig. 94, LEVEL 2, the images can be scaled to 1/4, 1/3, 1/2, based on screen reduction option, wherein upon selecting 1/4, for example the images have been processed to create a smaller representation of the received images to the s-means, thereby meeting the limitation of a thumbnail generator which reduces the images to one of a few fractional choices, based on screen size, therefore, since based on screen size, less pixels, based on screen size, therefore, the scaling meets the limitation of a thumbnail generator, by fractionalizing the images, as desired by the user, further see Figs. 95, 97, 99, wherein scaling can be accomplished from any medium, at any time, such as from the s-medium to s-means, wherein thumbnails can be created as desired (scaling), for images by user initiation.

Regarding claims 2 and 17, Yamauchi further meets the limitation of erasing images from the s-medium, after copying to s-means (Fig. 104 A, "deletion", Fig. 107, "DELETION DESTINATION memory card 1 or 2", even a deletion range, also Figs. 115 & 117).

Regarding claims 3 and 18, Yamauchi further meets the limitation of display means for displaying images stored in the s-means (the displaying of images can be done from any storage in the system Fig. 87 B, Fig. 88, "DISPLAY, from HDD or DDD to monitor").

Regarding claims 4-5, Yamauchi further meets the limitation of user initiated copying from s-medium (card) to s-means (HDD), wherein the user is provided with a switch met by

Art Unit: 2615

either the remote (Fig. 50, "239d", even Fig. 64) and/or keyboard or other, as shown in Fig. 74, wherein upon the user actuating the switch, a copy instruction is generated by the control unit a signal indicative of a copy instruction to the control means (Figs. 74-, etc.....).

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-4, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Schelling et al. (US 5,706,097).

Regarding claims 1 and 16, Schelling discloses and meets the limitations associated with an image storage method and corresponding apparatus comprising:

- receiving means (Fig. 2, "34 to 38" or Fig. 3, "46 to 53"), for receiving images stored in a storage medium (col. 3, "CD ROM" or "PCMCIA Card");
- storage means (PC 36) for storing the images received through the receiving means from the storage means and

using a copy instruction means (Fig. 2, user interface 42) for giving an instruction to copy the images stored in the storage medium into the storage means (col. 3, "The operator picks out the desired frames from the motion picture sequence ... **saves the frames in a format such as a PICT file**", therefore, saving images chosen from the CD-ROM, or read only memory, since, the saving of images are, chosen from the CD ROM, to be saved on the computer in a PICT file format, meeting the limitations of the s-means, for storing images from the s-medium);

Art Unit: 2615

- control means and thumbnail generator, for executing a control in such a manner as to receive the images from the storage medium through the receiving means and copy the images stored in the s-medium to the s-means without generating any thumbnails, when a copy instruction is given to copy the images (met by upon a selection of images from the computer, such as the user picking images of desired frames from the motion picture sequence and saves to a PICT file, on the computer, in view of the CD ROM source, thereafter, the PICT images can be deduced to the "thumbnail image", therefore the images are picked and converted and stored, prior to thumbnail generation using the stored files).

Regarding claims 3 and 18, Schelling further meets the limitation of a means to display images stored on the storage means or computer memory (Fig. 1).

Regarding claim 4, Schelling further meets the limitation of a switch {met by Keyboard}, which the keyboard is operated by the user to facilitate the copy process wherein it is inherent that a signal corresponding to a user command is generated to the controller to facilitate the copy process with a copy instruction to create the PICT file with images recorded thereto.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2615

6. Claims 2, 5, 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelling et al. (US 5,706,097).

Regarding claims 2 and 17, since Schelling discloses and meets the limitations of wherein the images can be provided to the computer (stored), for a user to select from and further {saved in a PICT format for example, computer memory}, and the later generate thumbnails, of the chosen and saved images, are later converted thru the thumbnail generator means provided, and further discloses wherein images can be provided from a PCMCIA memory card, which may be removed from a camera (col. 3), therefore, the storage means also reads on the camera PCMCIA memory card, but, as applied Schelling fails to disclose the apparatus further comprising an erasing means for erasing images from the s-medium after the images in the s-medium are copied to s-means.

The examiner takes official notice that it is well known to initiate erasing images from a memory card, after copying or downloading images, from the memory card thereby allowing the card to be used to store new images, as is well known.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Schelling, by providing a means to erase images from the PCMCIA/camera card for example, after downloading the images from the memory card, as is well known in the art.

Regarding claim 5, Schelling meets the limitations of providing a copy instruction with the keyboard when operated to copy images to s-means, but, fails to particularly disclose a remote control unit having a button to facilitate the copying.

The examiner takes official notice that it is well known in the art that systems can be provided with a remote control to facilitate control, providing an additional control means to the system, features already operable from the front panel of an apparatus, therefore, it would have been obvious to one skilled in the art at the time of the invention to provide a remote control to copy or to transfer files from a s-medium to s-means, corresponding to system functions with the remote, as is well known to those skilled in art.

Art Unit: 2615

Contact Fax Information

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

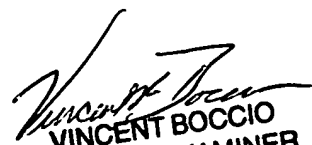
Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
4/29/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER